



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,845	05/05/2006	Milton Hammond	050193-0217	1942
20277 7590 07/28/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
NOLAN, JASON MICHAEL				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
07/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,845

Applicant(s)

HAMMOND ET AL.

Examiner

JASON M. NOLAN

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 2 is/are allowed.
6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/CIS)
Paper No(s)/Mail Date 12/7/05, 4/11/08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This Office Action is responsive to Applicants Transmittal of New Application, filed 12/07/2005. Claims 1-11 are pending in the instant application; of which Claims 1 & 11 are currently amended.

Information Disclosure Statement

Applicants' information disclosure statements (IDS), filed on 12/07/2005 and 04/11/2008 have been considered. Please refer to Applicants' copies of the 1449 submitted herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6, & 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Renslo et al. (US 7,279,494 - filed 04/01/2004). Said patent discloses compounds and compositions according to Formula I, shown in abstract and Claim 1 in column 144. There is significant overlap between formula I of the '494 patent and the instant application, including anticipatory species such as Example 70 shown in column 139 (A

Art Unit: 1626

= S(O); Rx = H; R1 = H; R4 & R4a = F; n = 1; R3 = NR13(C=X2)R12; R13 = H; X2 = O; and R12 = CH2CN), among others.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 & 8-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the claim is drawn to compounds of the formula I comprising the core variable ring (Ar or HAr). There are numerous examples in the specification wherein the core variable ring is phenyl; however, there are no examples drawn to core variable ring (Ar or HAr) other than phenyl. Therefore, there is not a representative number of examples and a person having ordinary skill in the art would recognize that applicant was not in possession of species having these necessary features.

Claim Rejections - 35 USC § 112, 1st Paragraph

Claims 9-11 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while enabling for compositions and a method of treating a bacterial infection, does not reasonably provide enablement for preventing a bacterial infection. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The nature of the invention

The nature of the invention is compounds and compositions of Formula I and methods of using these compounds as antibacterial agents.

The state of the prior art and the predictability or lack thereof in the art

The state of the prior art, namely pharmacological art, involves screening *in vitro* and *in vivo* to determine if the compounds exhibit desired pharmacological activities, which are then tested for their efficacy on human beings. There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face. The instant claimed invention is highly unpredictable as discussed below.

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. *In the instant*

case, the claimed invention is highly unpredictable since one skilled in the art would recognize that a group of compounds and compositions may treat a cell, once infected with bacteria, but it does not mean that the same group of compounds and compositions may prevent bacteria from infecting the cell. The term preventing may be interpreted as disallowing bacteria from entering a single cell.

The amount of direction or guidance present and the presence or absence of working examples

There is no direction or guidance provided which supports Applicant's claimed method for the preventing a bacterial infection, as indicated. The direction or guidance present in Applicants' Specification for a method of using the compounds and compositions of Formula I to bacterial infection is found on pages 44-45.

The breadth of the claims, quantity of experimentation, and level of skill in the art

Claims 9-11 are drawn to method of treating or preventing a bacterial infection. In order to prevent a disease, one would need to precisely identify those subjects likely to acquire such a disease, administer Applicant's claimed invention, and then demonstrate that if the identified subject did not develop the disease, such an effect was the direct result of administration of the claimed invention.

Because of the aforementioned reasons, a person of skill in the art could not practice the claimed invention herein, or a person of skill in the art could practice the claimed invention herein only with undue experimentation and with no assurance of success. Deleting the word "preventing" in the claims may overcome this rejection.

Claim Objections

Claim 1 is objected to because of the following informalities: the term "the present invention relates to" should be deleted. Appropriate correction is required.

Claim 8 is objected to because of the following informalities: the term "and optionally a in combination..." does not make sense. The "a" is probably inadvertent. Appropriate correction is required.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 7,141,588 and 6,919,329 disclose oxazolidinone derivatives structurally and pharmaceutically related to the instant compounds; however, the amide linkage to the oxazolidinone is not claimed in the instant application.

Allowable Subject Matter

Claim 7 is allowed.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jason M. Nolan, Ph.D./

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626